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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,171	12/20/2000	Bruno Johannes Ehmsperger	CM2128FQ/JH	8797

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/720,171	Applicant(s) EHRNSPERGER ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

1. Claims 1-11 are objected to because of the following informalities: In claims 1 and 5, the phrase "characterized in that" needs to be changed to --wherein-- or --comprising--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4, 6, 7, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 068 830. EP'830 teaches an article suitable for delivering or absorbing liquid comprising a lower substrate 9 and an upper substrate 10, each consisting of a layer of non-woven fabric 11 and laminated thereto on one side only a thin film 12 of polyethylene. The porous polymer film is interposed between two layers of substrate laminate and the whole are heat-sealed together along the edge regions in a grid pattern to form a plurality of compartments 15a, 15b, each containing a square 16 of porous material carrying liquid. Perforations 17 are provided in the upper layer 10 (page 18, lines 6-11, page 28, line 28 et seq., and figures 3 and 4). The porous polymer has a pore size meeting the specific range set out in the claims (table II, and page 7, line 2). Due to the variations of the numbers of perforations in each compartment, the compartment 15a releases its contents more rapidly than compartment 15b upon a hand pressure (page 29, lines 10-15). The porous

polymeric material carrying liquid is a vinyl polymer (page 11). Since EP'830 is using the same porous polymer material having the pore size set out in the claims to form the membrane (substrate laminate) as Applicant, a bubble point pressure would be inherently present within the range as set forth in the claims. EP'830 is silent as to the substrate laminate being hermetically sealed to or around the reservoir. It is the examiner's position that the article of EP'830 is identical to the claimed article prepared by the method of the claim, because both articles are made of the same materials, having structural similarity (a substrate laminate sealed to a reservoir). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The EP'830 reference anticipates the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with EP'830.

Claim Rejections - 35 USC § 103

Art Unit: 1771

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

EP 0 068 830. EP'830 teaches the porous polymer material having the pore size of 0.5 to 100 microns and the void volume of 70-80% (page 7, lines 2 and 13).

However, such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product, such that the larger pores would provide a faster rate of liquid delivery while smaller pores would provide a slower rate of liquid delivery. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the porous polymer material having the pore size instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

EP'830 is silent as to the volume of liquid reservoir varying by the action of a piston.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the hand pressure and piston to varying the volume of the liquid reservoir described in the claim since the examiner takes Official Notice of the equivalence of the hand pressure and the pressure produced from the action

of a piston for their use in the pumping art and the selection of any of these known equivalents would be within the level of the ordinary skill in the art.

6. Claims 1-5, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 488 665. EP'665 discloses a device comprising a porous core containing one trapping agent, water and a gelling agent and the core being enclosed by a semipermeable gas membrane made of porous PTFE film (figure 2). EP'488 is silent as to the membrane being hermetically sealed to the core. It is the examiner's position that the article of EP'665 is slightly different than the claimed article prepared by the method of the claim, because both articles are made of the same materials, having structural similarity (a membrane sealed to a reservoir). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The EP'665 reference strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and

Art Unit: 1771

how the Comparative Examples are commensurate in scope with EP'665. EP'665 is silent as to the porosity and the pore size of the membrane. However, such a variable would have been recognized by one skilled in the art to control the rate of the suction pressure to be applied, such that the larger pores would provide sufficient sucking force while smaller pores would require less sucking force. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the porous polymer material having the pore size instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al (US 5,678,564). Lawrence teaches a liquid removal system comprising an interface device having a porous membrane 25 and drain tube 26 connected to the foam material 27. The porous membrane and the drain tube are hermetically sealed to the shell 28 that contains the foam material or fibrous material 27 (figure 2a, column 6, lines 1-20). The membrane has an average pore size of 15 to 20 microns (column 6, line 29). However, such a variable would have been recognized by one skilled in the art to control the rate of the suction pressure to be applied, such that the larger pores would provide sufficient sucking force while smaller pores would require less sucking force. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art

Art Unit: 1771

at the time the invention was made to employ the membrane having the pore size instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. The urine is removed from the interface device is enhanced by the application of a continuous suction force to the drain tube (column 7, lines 48-57). Lawrence does not specially disclose the bubble point pressure of the membrane. Since the device of Lawrence is meets the recited structure set out in the claims, it is the examiner's position that the bubble point pressure would be inherently present.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426.

The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700